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REMARKS

This Application has been carefully reviewed in light of the Non-Final Office Action mailed September 29, 2005 ("Office Action"). Claims 1-21 are currently pending.

Allowance of Claims 6-9 and 21

Applicants note with appreciation the allowance of Claims 6-9 and 21.

Section 103 Rejections

Claims 1-5 and 10-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,742,762 issued to Scholl et al. ("Scholl") in view of U.S. Patent No. 5,862,481 issued to Kulkarni, et al. ("Kulkarni") and U.S. Patent No. 6,539,337 issued to Sayers, et al. ("Sayers"). Applicants traverse these rejections.

Independent Claim 1 is allowable over the proposed combination of *Scholl*, *Kulkarni*, and *Sayers* because the proposed combination would render *Scholl* "unsatisfactory for its intended purpose."¹ Clearly, one would not be motivated to combine references in a manner that would make the references unsatisfactory for their intended purpose. Accordingly, there is no suggestion or motivation to make the proposed combination.

The Office Action acknowledges that *Scholl* does not disclose "a protocol mediator coupled to the first and second wireless networks, the protocol mediator operable to translate between the first management protocol and the second management protocol." See Office Action, page 3. Therefore, the Office Action proposes combining features from *Kulkarni* to meet this limitation. Particularly, the Office Action indicates that *Kulkarni* "teaches the use of a specific protocol mediator (GIP) to translate between a first management protocol and a second management protocol." See Office Action, page 3. With this, the Office Action proposes combining such a feature with *Scholl*. However, this proposed combination renders *Scholl* unsatisfactory for its intended purpose of using the appropriate network management protocols to communicate with each managed network. Particularly, with reference to Column 7, lines 36-48 and Column 8, lines 42-49, *Scholl* discusses how *Scholl*'s invention uses the appropriate networking protocol to communicate with each managed network by

¹ See MPEP 2143.01 ("If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

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converting a network management request (NMR) to the appropriate networking protocol. If the appropriate networking protocol is utilized as disclosed in *Scholl*, then no translation of management protocols would be needed. Accordingly, the proposed modification would add unintended inefficiencies to *Scholl* and render *Scholl* unsatisfactory for its intended purpose — using the appropriate networking protocol to communicate with each managed network. Clearly one of ordinary skill in the art would not be motivated to make this modification. For at least this reason, a *prima facie* case of obviousness has not been established. Accordingly, Applicants submit that Independent Claim 1 and its dependents, Claims 2-5, should be allowable. Independent Claims 10, 16, 20 and 21 and their dependents, Claims 11-15 and 17-19, should be allowable for analogous reasons.

Independent Claim 1 is further allowable over *Scholl*, *Kulkarni*, and *Sayers* because the PTO has improperly picked features from *three* separate references to the exclusion of the teachings of the remainder of such references. To this end, Applicants respectfully remind the PTO that in making a determination of obviousness, “the prior art as a whole must be considered. The teachings are to be viewed as they would have been viewed by one of ordinary skill.” *In re Hedges*, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986) (emphasis added). “It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” Id.

In the PTO’s “picking” of features from the three references, Applicants point out that each of the systems in each of the references are specifically designed for a particular purpose. For example, the system in *Scholl* is directed towards a management of networks using a Web client. See *Scholl* abstract. The system in *Kulkarni* is directed towards an internetworking proxy which translates between first and second management protocols used by first and second systems. See *Kulkarni* abstract. The system in *Sayers* is directed towards a communication system that permits users to operate freely in both public and private wireless networks using standard mobile stations. See *Sayers* abstract. Further, some of the references have several separate systems designed for different purposes. Applicants submit that features of these systems do not lend themselves in an obvious manner to being individually “picked” out for recombination without the Applicants’ disclosure in hand. Such is evident, for example, as described above with reference to the proposed combination of features in

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Scholl, Kulkarni, and Sayers — such a recombination rendering *Scholl* unsatisfactory for its intended purpose.

Applicants additionally challenge the Office Action's alleged motivation to combine and modify features from the proposed references. The motivation to combine *Kulkarni* with *Scholl* was provided in the Office Action as follows:

... to provide the management protocol conversion between managed networks to further improve the system compatibility and flexibility ...

(Office Action, Page 3.) and the motivation to combine *Sayers* with *Scholl* was provided in the Office Action as follows:

... to provide the system with wireless capability to further improve the system speed and efficiency ...

(Office Action, Pages 4-5.) Such conclusory reasoning falls short of the required evidence of a motivation to combine and/or modify prior art references. See *Ex Parte O'Donnell*, Appeal No. 2004-0421 (The Board found that the Examiner's reason, "it would have been within the scope of one of ordinary skill in the art to combine the teachings of [the references] to achieve further corrosion resistance," an inadequate reason as to why there is a motivation to combine the references.). With regards to the "system compatibility and flexibility" motivation, Applicants note that *Scholl* already provides a feature for system compatibility: using the appropriate network management protocol — avoiding a need for translation. Accordingly, such a motivation is contrary to specific teachings of the references. With regards to the "improve the system speed and efficiency" motivation, Applicants noted above that the Office Action's proposed combination would reduce the efficiency of *Scholl*. Accordingly, such a motivation would lead one of ordinary skill in the art to not make the proposed combination of *Kulkarni* with *Scholl*.

Applicants remind the PTO that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See, e.g., *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts

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necessary to arrive at the claimed...salt."). Further, "[t]he factual inquiry whether to combine references must be thorough and searching." (*In re Sang-Su Lee*, 277 F.3d 1338, 1343). "[An] examiner's conclusory statements . . . do not adequately address the issue of motivation to combine." *Id.* Furthermore, simple hindsight speculation that "it would have been obvious" to make the proposed combination is insufficient under M.P.E.P.² guidelines and governing Federal Circuit case law.³ Moreover, such statements and assumptions are inadequate to support a finding of motivation, which is a factual question that cannot be resolved on "subjective belief and unknown authority."⁴

Should any of the above asserted rejections be maintained, Applicants respectfully request appropriate evidentiary support. Additionally, if the Examiner is relying upon "common knowledge" or "well known" principles to establish these rejection, Applicants request that a reference be provided in support of this position pursuant to M.P.E.P. § 2144.03. Furthermore, to the extent that the Examiner maintains any rejection based on an "Official Notice" or other information within the Examiner's personal knowledge, Applicants respectfully request that the Examiner cite a reference as documentary evidence in support of this position or provide an affidavit in accordance with M.P.E.P. § 2144.03 and 37 C.F.R. 1.104(d)(2).

No Waiver

All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the *Scholl*, *Kulkarni*, and *Sayers* references. Other distinctions may exist, and Applicants reserve the

² See, e.g., M.P.E.P. §2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

³ For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (*emphasis added*) (*citations omitted*).

⁴ See *In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

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right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicants are sufficient to overcome the anticipation and obviousness rejections.

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CONCLUSION

For the foregoing reasons and for reasons clearly apparent, Applicants respectfully request allowance of all pending claims.

If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stand ready to conduct such a conference at the convenience of the Examiner.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 19-2179 of Siemens Information & Communications Products, L.L.C.

Date: 12/21/07

Respectfully requested,

SIEMENS CORPORATION
Customer No. 28524
Attn: Elsa Keller, Legal Department
170 Wood Avenue South
Iselin, NJ 08830
Telephone: (650)694-5191

By: Anand
Anand Sethuraman
Registration No. 43,351
Attorney for Applicants
Tel: 650-943-7554